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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,807	01/03/2002	Michael J. FAWCETT	H053310.0000US	6737
7590 04/20/2004			EXAMINER	
John F Luman III Akin Gump Strauss Hauer & Feld 711 Louisiana Suite 1900 Houston, TX 77002			GILMAN, ALEXANDER	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/890,807		Applicant(s) FAWCETT ET AL.	
	Examiner Alexander D Gilman		Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9, 11, 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 11, 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 10-11 , recites " means for ensuring that on interengagement the contact holder is not displaced from the first to the second position...

Claim 1, lines 14-15 , recites " means for ensuring that on disengagement the contact holder is displaced from the second to to the first position...

Claim 1, lines 16-17 , recites " means ... for locking the contact holder to said contact of the other connector elements ".

The means for ensuring (means 1) and means for locking (means 2) are not adequately described in the specification . It is not specified, it is not structurally supported which of elements are related to means 1 (which of "individual components" – the term used in the Remarks of Amendment filed 01/21/04 – comprise means 1) and which of elements are related to means 2 (lock balls only or lock balls and other individual components that comprise each of means 2).

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If claim is interpreted under 112 paragraph 6, the specification should adequately describe the corresponding structure that carries out the recited function in the claims. This requirement is satisfied if the written description links or associates particular structure to the recited function. Additionally Remarks of the Amendments suggest that alternative arrangements (not described in the Specification) can be interpreted as the respective means (Remarks , p. 5 of the Amendments, the last section)

Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5 are, as they can be understood due to the 112 problem, rejected under 35 U.S.C. 102(b) as being anticipated by Bac.

Bac (US 3,360,764) discloses a connector comprising (Fig. 1-3):

first (A) and second (B) connector elements,

the first connector element (A) supports a first contact (13),

a displaceable (in a casing 3) contact holder (15, 21), carrying second (25) and third (26) contacts,

wherein

on interengagement the contact holder is displaced from first (Fig. 1) to second (Fig. 2) position after the third contact (26) is interconnected with a contact (36) of the other connector element (col. 6, lines 23-42);

on disengagement the first and second contacts separate before the third contact is separated (col. 6, lines 49-59);

the first contacts and second contacts , when separated, are located within a chamber (Fig. 1),

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means for ensuring and locking the contact holder to the other contact element (137, 128, 116, 140, 161; see also col. 7, lines 12-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-8, and 11-13 are, as they can be understood due to the 112 problem rejected under 35 U.S.C. 103(a) as being unpatentable over Bac.

With regard to claim 2, Bac discloses all of the limitations except for both connector elements having the contact holder for interconnection the first, second and third contacts.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide both connector elements having the contact holder for interconnection the first, second and third contacts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

With regard to claims 3, 4, 11, and 12, Bac discloses the structural features which can be used to prevent the holder being blown out of the associated connector element – pin (19) on the contact holder and a slot (20) in the body of connector element.

To locate the pin and the slot in reversed order (as claimed) and provide the slot with the closed end (to prevent removing the holder from the connector element) would have been an obvious matter of design absent any criticality and since the function performed by the elements is the same.

With regard to claims 6-9, 13, Bac discloses all of the limitations except for the locking means applied to the connector element (A) with the first, second, and third contacts.

Bac discloses (Fig. 3) the locking means applied to the connector element (B):

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the connector balls (140) between the connector element (105) and the contact holder (128, 131) (claim 6);

means for locking including balls (140) and a spring-biased slider (155) (claims 7-9, 13).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the connector element A with the locking means, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

Response to Arguments

Applicant's arguments filed 01/21/2004 have been fully considered but they are not persuasive. With regard to claim 1, Applicant argues that the prior art (Bac) fails to disclose that the first and second contacts becoming interconnected after the third contact is connected to a contact of another connector.

Also, Applicant argues that disconnection in Bac will not be in claimed order.

As it was shown in the Office rejections, Bac discloses (col. 6, lines 23-42) the claimed order of connection. According to Bac, the third contact (26) is engaged with the contact (36) of another connector (B) when collar (40) touches the wall (2). Movement of the block (21) with the embedded contacts (26) toward the first contact (13) can start only when the portion (29) will strike against collar (16). The subsequent movement of the block (21) with the third contact (26) and the contact (36) already engaged will lead to engagement of the first contact (13) with the second contact (25).

Analogously, Bac (col. 6, lines 49-59) discloses the reversed order of disengagement -- the first and second contacts separate before the third contact is separated.

The respective structural features (means) are provided (Fig. 3). The locking balls (140 and 161) ensure that block (121) of Bac will connect block (111) and block (131) in the order claimed. (Col. 12-31 – engagement; Col. 8, lines 33-45).

Hence, the rejection deems to be proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander D Gilman whose telephone number is 571 272-2004. The examiner can normally be reached on Monday-Friday, 10:30 a.m. - 8:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571 272-2800 ext. 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

04/15/2004


ALEXANDER GILMAN
PRIMARY EXAMINER